

The opinion in support of the remand being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

APR 30 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RENE LANGHANS

Appeal No. 2001-2591
Application No. 08/883,685

HEARD: April 10, 2002

Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

REMAND TO THE EXAMINER

Rene Langhans originally took this appeal from the final rejection of claims 1 through 3, 5 through 8, 10 through 12 and 14 through 21, all of the claims pending in the application. At the oral hearing, the appellant's counsel, Mr. John C. Linderman, stated that the appellant wished to withdraw claims 7 and 21 from the appeal. In accordance therewith, the appeal as to claims 7 and 21 is hereby dismissed.

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The claims remaining on appeal, claims 1 through 3, 5, 6, 8, 10 through 12 and 14 through 20, stand rejected (1) under 35 U.S.C. § 112, first paragraph, as being based on a specification which is non-enabling, (2) under 35 U.S.C. § 112, second paragraph, as being indefinite, and (3) under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,116,098 to Suzuki et al. (Suzuki). Before reviewing the merits of these rejections, we find it necessary to remand the application to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for action consistent with the following remarks.

I. The application file contains a reply brief which appears to have been submitted on May 24, 2001 along with a request for oral hearing and a petition to the Commissioner (Paper No. 43).¹ The record lacks any indication, however, that the examiner treated this reply brief in accordance with 37 CFR § 1.193(b)(1) which states in pertinent part that "[t]he primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief." On remand, the examiner is directed to so treat the reply brief.

¹ Neither the reply brief nor the request for oral hearing has been assigned a paper number or listed in the file wrapper table of contents.

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II. The record includes documentary evidence first submitted by the appellant on March 23, 2001 (Paper No.40) in traverse of the examiner's 35 U.S.C. § 112, first paragraph, rejection, and resubmitted on March 26, 2001 (Paper No. 42) and then again with the reply brief. Although the examiner has indicated that the first two submissions have not been considered (see Paper Nos. 41 and 45), the accompanying explanations are unclear as to whether this decision stemmed from a determination that the evidence should be denied entry for cause (e.g., untimeliness) or from a conclusion that the examiner lacked jurisdiction to even entertain the question of entry/non-entry. On remand, the examiner is directed to take this issue up on its merits and either enter or refuse to enter the evidence.

III. Finally, the examiner is directed on remand to reconsider the 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 102(b) rejections, and, if it is decided that these rejections should be maintained, issue a supplemental examiner's answer containing:

a) a specific explanation as to why a relative lack of detail in the specification and some minor inconsistencies in the drawings would have prevented a person of ordinary skill in the art from making and

using, without undue experimentation, a device having the relatively simple and straightforward cutting gap establishing and adjusting means described on specification pages 5 and 7, shown in Figure 4 and recited in claims 1 and 18;²

b) a specific explanation as to how and why the comparison between the prior art and the appellant's invention described on specification pages 7 and 8 and shown in Figures 5 and 6 would have prevented a person of ordinary skill in the art from making and using, without undue experimentation, the structure recited in the claims on appeal;

c) an elaboration of the examiner's position as spelled out in the answer (Paper No. 39) as to how the apparatus disclosed by Suzuki meets the specific limitations in claims 1 and 18 relating to the U-shape

² Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.


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frame and the non-positive or frictional drive connection, since such is not readily apparent; and d) an explanation of the examiner's substantive position on the appellant's evidentiary submission if such should be entered.

This application, by virtue of its "special" status requires an immediate action. MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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